

No. 4582.

IN THE

United States

Circuit Court of Appeals,

FOR THE NINTH CIRCUIT. 3

David G. Lorraine, and The Lorraine
Corporation, a corporation,

Appellant.

vs.

Francis M. Townsend, Milon J. Trum-
ble and Alfred J. Gutzler, doing
business under the firm name of
Trumble Gas Trap Company,

Appellees.

APPELLEES' OPENING BRIEF.

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FILED

OCT 11 - 1912

F. D. MONROE

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APPELLEES' OPENING BRIEF.

From a final decree dismissing plaintiffs' bill of complaint and supplemental bill of complaint, plaintiffs appeal.

Herein the parties will be referred to as they appeared in the District Court, to wit: appellants as "plaintiffs", and appellees as "defendants."

The suit is the usual one upon Letters Patent of the United States for an injunction to prohibit alleged infringement and for an accounting of profits and damages.

The patent in suit is a reissued patent, No. 15,220, granted November 8, 1921, in substitution for original Letters Patent of the United States No. 1,373,664, dated April 5, 1921. The patent refers to *Improvements* in Gas, Oil and Sand Separators.

The construction of the device illustrated in said original Letters Patent No. 1,373,664 has already been considered by this Court.

Defendants are owners of the Trumble patent 1,269,134, granted July 11, 1918. Under this Trumble patent, defendants have long been engaged in the manufacture and sale of gas-traps, denominated in the Trumble patent "crude petroleum and natural gas separators." Defendants had established a prosperous business in the manufacture and sale of such Trumble gas-traps, which had become the standard gas trap for use at producing oil wells. Sale of such Trumble traps by defendants commenced in 1915.

The plaintiff David G. Lorraine conceived what he believed to be *an improvement in the valve mechanism* of such trap. He sought to interest the defendants in such alleged invention and to sell the invention to defendants. Failing to make a deal with defendants, plaintiff David G. Lorraine conceived the idea of going into the gas trap business, as he coveted the business enjoyed by defendants. In pursuance of such desire to divert to himself the good-will of defendants' established business, the plaintiff David G. Lorraine designed the specific construction of gas trap shown in said original patent 1,373,664, embodying therein the valve mechanism (which he had represented to de-

fendants he had invented) and commenced to manufacture and sell such traps. But he modified some of the details of construction from the trap depicted in the patent drawing. In particular, he extended the deflector cone or plate 17 so as to cause the baffle-plate or cone 17 to distribute "approximately the whole body of oil in an unbroken condition to the adjacent segment of the chamber wall, down which it flowed substantially as in the Trumble device" (290 Fed. bottom p. 59). No other construction of trap closely approximating the detail construction depicted in this Lorraine patent was ever manufactured or installed by either of the plaintiffs.

Thereupon defendants brought suit against plaintiff David G. Lorraine in the United States District Court for the Southern District of California for infringement of said Trumble patent 1,269,134, and particularly claims 1, 2, 3 and 4 thereof.

After this suit had been pending some time, and just before its trial before Judge Wolverton, plaintiff herein, David G. Lorraine, changed the construction of his gas traps. These defendants thereupon filed a supplemental bill of complaint at the trial, bringing therein as an alleged infringement such modified form and construction of Lorraine gas trap.

At the trial Judge Wolverton held that both the construction of gas trap shown and described in the Lorraine patent 1,373,664 and the modified Lorraine construction infringed the Trumble patent. An interlocutory decree awarding an injunction and an accounting of profits and damages was entered.

From this decree plaintiff herein, David G. Lorraine, appealed. This Court on June 4, 1923, rendered its opinion upon such appeal (290 Fed. 54). This Court held that in view of the prior art and prior patents, the Trumble invention was of relatively limited scope. This Court held the Trumble patent to be infringed by the Lorraine trap as shown in the Lorraine original patent 1,373,664, as exemplified in the first traps constructed and installed by Mr. Lorraine, (for example, on the Tonner well No. 3, referred to by Judge Wolverton in his opinion as "Model No. 1".) See particularly 290 Fed. at p. 59. This Court, however, reversed Judge Wolverton's decree in so far as it liberally construed the said Trumble patent and decreed the same infringed by the second or modified form and construction of the Lorraine gas trap, which latter departs essentially from that depicted in the Lorraine patent.

It is thus seen that this Court thus adjudicated said case by a finding that the business of the plaintiff David G. Lorraine had its incipency in the piracy of defendants-appellees' patent rights. In effect, such adjudication necessarily included and implied that plaintiff Lorraine was a mere improver in details of construction.

The present suit was commenced on January 22, 1922, after the suit upon the Trumble patent had been set for trial, and just before the trial thereof which commenced on March 22, 1922. Obviously, the suit was filed for two purposes. One was for a hoped effect upon the Trumble trial, and the other

was to effect a counter-charge of infringement which could be circulated amongst defendants-appellees' trade.

It should be noted that although the original Lorraine patent issued April 5, 1921, and the original suit upon the Trumble patent had been filed on January 3, 1921, no counter-suit was brought upon the original Lorraine patent. Nor was any counter-suit brought on the Lorraine reissued patent until on the eve of the Trumble suit.

The proofs fully show that long prior to the application for the reissue of the Lorraine patent, defendants had been manufacturing gas traps identical in construction with those asserted in this suit to infringe the Lorraine patent as reissued, and that Mr. Lorraine had full knowledge of this prior to his application for a reissue of his original patent.

The proofs show that these defendants had their attention called to the original Lorraine patent shortly after its issue. The defendants caused said original patent to be examined, and defendants both themselves determined therefrom, and were advised by their patent counsel, that such original Lorraine patent was addressed to, covered only, and was limited to the specific details of construction shown and described in such patent and to the specific valve arrangement which plaintiff David G. Lorraine had asserted to these defendants he had invented, and in which defendants were not interested, and which they have never used, and which they are not even charged with ever having used. Defendants were advised that no gas trap manufactured by them embodied anything covered by said

original Lorraine patent. Relying upon the limited character of said original Lorraine patent, defendants proceeded with the further extension of their business and the manufacture and sale of such non-infringing traps.

There is no issue in this case upon this fact: Said original Lorraine patent 1,373,664 was limited to the specific form and construction therein shown and to the particular valve mechanism arrangement therein shown and described. This is an admitted fact.

It is obvious, therefore, that the reissued Lorraine patent in suit must be a broadened patent, or it could not be infringed. If the reissue had been for the purpose of narrowing the original patent, then, in as much as it is conceded none of defendants' gas traps infringed the original patent, none of them could be contended to infringe the reissued patent.

We shall point out in detail later that the Lorraine reissued patent is, in law, for a different invention than that for which the original was granted. By such statement we do not mean merely that the attempted scope of the reissued patent is more comprehensive or that the claims are in more general terms, but, on the contrary, that both the specification and statement of the invention and the technical claims are addressed to an alleged different invention from that for which the original patent was granted. By the term "different invention" herein, we refer to a different invention under that rule of law, well established by the Supreme Court, that reissued patents must be for the same invention as sought to be

patented in and by the original patent. The original patent was granted for a mere improvement in details of the specific construction and arrangement of the partitions of the gas trap whereby it was divided into chambers located and arranged in specific relations one to another (claims 1 and 2) and to a specific valve mechanism (claims 3, 4 and 5).

This suit is not based upon any of the claims of the original patent. The five claims of the original patent are repeated as claims 1 to 5, respectively, of the reissued patent. Fourteen additional claims, numbered 6 to 19, appear in the reissued patent. Infringement, however, is charged only of the last three claims of the reissued patent, to wit: claims 17, 18 and 19.

The Defendants' Gas Trap.

The gas trap manufactured and sold by defendants, and asserted to infringe claims 17, 18 and 19 of this Lorraine reissued patent, are substantially identical with the trap shown and described in the Trumble patent 1,269,134 and with the gas traps manufactured and sold by defendants for years prior to Mr. Lorraine's original application for the original patent 1,373,664. It is not asserted or claimed on behalf of the plaintiffs that defendants have adopted or used any element invented by Mr. Lorraine, nor any detail of construction invented by Mr. Lorraine, or that defendants have changed the construction of their Trumble trap in any mechanical feature.

Defendants have used various forms of valves. In some of defendants' traps the valve operating mechanism has been located within the chamber of the trap. In others, external of the body of the trap. Both types and constructions were used by defendants long prior to Mr. Lorraine's alleged invention and years prior to his application for patent. No claim, however, is made by plaintiffs that at any time have defendants used the valve mechanism which Mr. Lorraine claims to have invented.

All traps manufactured by the defendants have been manufactured in substantial accordance with the Trumble patent 1,269,134. In all the Trumble traps the incoming stream of oil and gas from the well is delivered onto a spreader cone 22 (Trumble patent) and by the spreader cone spread out on the walls of the trap, thus utilizing this principle of the Trumble invention. Defendants have never departed therefrom. The number of spreader cones embodied in defendants' trap has varied. This is true both prior and subsequent to Lorraine's alleged invention and prior and subsequent to the issue of the Lorraine patent. Some of defendants' traps have been provided with only one spreader cone, others with varying numbers.

No changes whatever have been made in the cooperative relations of the various elements of defendants' Trumble trap. All of defendants' Trumble traps have been provided with "an expansion chamber arranged to receive (from the well) oil and gas in its upper portion"; all have been provided with the spreader cone forming "means for spreading the oil

over the wall of such chamber to flow downwardly thereover”; all have been provided with “gas take-off means arranged to take off gas from within the flowing film of oil”; all have been provided with “an oil collecting chamber below the expansion chamber”; all have been provided with “an oil outlet from said collecting chamber”; and all of them have been provided with “valve controlled means arranged to maintain a submergence of the oil outlet”,—as explained in the Trumble patent and set forth in claim 1 thereof. Valves of different constructions have been used. Such valves have been arranged both internally (within the trap as depicted in the drawing of the Trumble patent), and externally of the trap (as shown in various exhibits). Infringement, however, is not charged or asserted because of any particular valve mechanism.

What, then, is the asserted Lorraine invention which defendants are claimed to have infringed? Obviously, such Lorraine invention cannot be patentably novel and exist in anything depicted in the Trumble patent or in any of the Trumble traps manufactured and sold by defendants prior to the alleged date of the alleged Lorraine invention. It is obvious, therefore, that not only were there many gas traps prior to Trumble,—(as determined by this Court in *Lorraine v. Townsend*, 290 Fed. 54, including *Cooper*, to whom patent No. 816,409 was issued on March 20, 1906; *MacIntosh*, patented March 11, 1913, No. 1,055,549; and *Bray*, patented June 16, 1912, No. 1,014,943,)—but the art prior to the alleged Lorraine invention also comprehended the Trumble invention and all of the disclosures

of the Trumble patent. Nothing depicted in the Lorraine patent which is common to any of these prior gas traps or prior patents, can be the Lorraine invention.

Having thus subtracted from the gas trap of the Lorraine patent all that was thus old and well known in the gas trap art, what new thing invented by Lorraine is it that defendants have wrongfully used?

The Court will search in vain the Appellants' Brief for an answer to this question.

The failure of plaintiffs-appellants to succinctly point out what it was that they claim Mr. Lorraine invented—what they claim was really his novel conception or idea that has been “pirated” by these defendants—has not been due to inadvertence on their part. Such failure is inherent in their asserted cause of action. Notwithstanding that this case was originally tried in open court before the late Honorable Judge Oscar A. Trippe, (who died before the rendering of a decision), and has again been tried *de novo* in open court before the Honorable William P. James, no such succinct statement of claimed invention has ever been made on behalf of the plaintiffs. This was brought directly to the attention of plaintiffs at the trial in the District Court. (See, for example, Transcript, bottom of p. 74.) During the oral arguments his Honor Judge James in vain requested plaintiffs' counsel to state precisely what was asserted to be the Lorraine invention. Plaintiffs' counsel evaded an answer.

We invite the attention of the Court to the patent in suit in order to determine this question.

The Patent in Suit.

The Supreme Court says:

“It is as important to the public that competition should not be repressed by worthless patents as that the patentee of a really valuable invention should be protected in his monopoly.”

(Pope Mfg. Co. v. Gormully, 144 U. S. 224, 234.)

In the patent in suit Mr. Lorraine has illustrated a gas trap in which he divides the interior of the receptacle

“into two separate segmental chambers, by means of a vertical partition arranged therein and in communication at the top of the receptacle with the gas collection chamber, and at the bottom thereof with the oil receiving portion of the receptacle. The oil with its constituent elements is delivered from the well into the upper portion of the receiving chamber on one side of the said partition, which is relatively smaller than the other chamber of the receptacle, and the oil or emulsion rises to a higher level in the receiving chamber than the level of the volume of oil in the main chamber.” (Reissue patent in suit, p. 1, lines 58-71.)

In the drawings, this separation into two chambers is accomplished by means of the vertical partition 19. The purpose and function of this construction is thus stressed in the Lorraine reissue patent:

“The arrangement of the said partition prevents the disturbance of the main volume of oil and permits the settling of the sand and water to

the bottom of the tank, while the injection of the oil and its constituent elements from the well into the receiving chamber of the receptacle liberates a large volume of gas, as the oil enters the receptacle and thus the gas liberated collects in the upper portion of the receptacle. The heavier elements settle to the bottom of the tank and rise to and maintain a substantially uniform level in the main chamber thereof." (Reissue patent in suit, p. 1, lines 71-84.)

"The lower end of this partition 19 may terminate or have communication with the opposite chamber well above the bottom of the receptacle and the partition forms a confined vertical passageway or chamber down which the oil issuing from the mouth 18 of the inlet sleeve 15 is directed and is caused to pass beneath the lower edge of, or through the partition 20 before the lighter materials, such as gas and oils, can rise to a predetermined variable height in the receptacle. This enables the sand that may be contained in the oil or emulsion, coming from the supply pipe 12, to settle toward the bottom while the oil passes around the lower edge of or through parts in the partition and ascends in the larger compartment formed on the opposite side of the partition. The upper end of said partition may also terminate short of the top of the receptacle or have parts there in communication with the gas chamber." (Reissue patent in suit, p. 2, lines 94-115.)

In his description of the operation of the patented gas trap, Mr. Lorraine says:

"The oil mass, or emulsion in some cases, passes beneath the lower end of or through the

partition 19 and thus facilitates the deposit or separation of solids such as sand or other heavy substances, and the lighter portion of the oil with the gas and the emulsion rises into the larger compartment of the receptacle and passes upwardly to a level that is determined by the position of the pneumatic float 56.” (p. 3, lines 106-115.)

* * * * *

“Preferably water is maintained in the bottom of the receptacle to a level somewhat above the lower end of the sand sheet or partition or part therein, so that the incoming supply of oil when passing below the lower end of or through the partition is brought into contact with the water and the attrition between the emulsion causes a rapid separation of the gaseous content as the oil and mixture engages the water.” (p. 4, lines 59-68.)

* * * * *

“It will be further understood that because of the vertical partition within the separating receptacle and the provision of the separate receiving and separating compartments, the products of the well are delivered into the smaller receiving chamber and all of the agitation of the oil is effected in the receiving chamber, while the main volume of oil is maintained at a stationary level and without agitation in the larger settling chamber of the receptacle. Now, this in the case of oil and gas other than emulsion is effected without pressure. The tendency of oil and products is to create pressure when the same is agitated in the receptacle and by the provision of the partition receptacle described herein. This

agitation and the consequent increase of pressure within the receptacle is entirely eliminated and the gas is allowed to flow freely from the gas collection chamber in the minor and upper portion of the receptacle.” (p. 4, lines 106-127.)

This specific form of division of the gas trap cylinder into two vertical chambers arranged side by side and intercommunicating at the bottom, forms an essential difference in structure between the Trumble gas trap (as patented and as manufactured by defendants both prior to Lorraine’s alleged invention and subsequent thereto) and the Lorraine gas trap. No Trumble gas trap has ever been built upon any such principle. On the contrary, all of defendants’ gas traps have been constructed with cones or spreader plates 22 (Trumble patent) at the top of the cylindrical gas trap. Thereby the distinguishing mode of operation of the Trumble invention has been produced and accomplished. Thereby the incoming intermingled oil and gas or oil, sand and gas is distributed onto the surface of such cone and by it deflected to and directed onto the inner surface of the shell of the trap, down which it flows in a thin film or sheet. This is well brought out in both the Trumble patent and in the opinion of this Court in 290 Fed. p. 54.

Not only, therefore, is the mechanical structure different, but the mode of operation and principle is different.

If, then, this be the novel feature of the Lorraine reissued patent, there can be no infringement. Not only is the structure of defendants’ traps solely that of

the art prior to the alleged Lorraine invention, but the changed mode of operation produced by the Lorraine structure has not been adopted or used in the defendants' trap.

“Rule XI. Where the mode of operation of the alleged infringement is substantially different from that of the patent in suit, infringement does not exist.”

(Hopkins on Patents, Sec. 279.)

“If the device of the respondents shows a substantially different mode of operation, even though the result of the operation of the machine remains the same, infringement is avoided.”

(Cimiotti Unhairing Co. v. American Co., 198 U. S. 399, at 414.)

Union Co. v. Battle Creek Co., 104 Fed. 337, 343;

Brooks v. Fiske, 15 How. 212, 221;

Jewell Filter Co. v. Jackson, 140 Fed. 340;

H. F. Brammer Mfg. Co. v. Witte Hdwe. Co., 159 Fed. 726, 728.

In *Union Steam Pump Co. v. Battle Creek Co.*, 104 Fed. 337, 343, the Circuit Court of Appeals for the Sixth Circuit says:

“If, however, such changes of size, form, or location effect a change in the principle or mode of operation such as breaks up the relation and co-operation of the parts, this results in such a change in the means as displaces the conception of the inventor, and takes the new structure outside of the patent.”

If patentable novelty can be assigned to the specific arrangement of the vertical side by side chambers with their intercommunication at the bottom of a vertical partition below which is formed a settling chamber, (as thus stressed in the Lorraine patent), it necessarily follows that the invention exists in and is limited to the changed principle of operation incident to such specific form and location of these chambers. If patentable invention can be predicated upon this difference between this specific construction and the well known prior art construction as exemplified in either the Bray patent 1,014,943, of June 16, 1912, or the Trumble patent 1,269,134, of 1918, such patentable invention cannot be construed of such breadth of novelty as to include within it such prior construction. If, then, this is plaintiffs' case, it falls by its statement. No trap manufactured or sold by defendants embodies this construction or the principle of operation thus stressed in the Lorraine reissued patent. In considering the claims asserted to be infringed, we shall further refer to the fact that defendants' Trumble traps have all retained the principles of construction and the novel principle of operation of the Trumble patent; in so far as this vertical arrangement of chambers marks a change in principle or function or anything more than the merest selection and designer's skill, the essential fact remains that defendants have never availed themselves of it. On the contrary, defendants have always utilized the Trumble design.

This alleged improvement was patented in the original Lorraine patent 1,373,664. See particularly claims

1 and 2 thereof. These claims are repeated in the re-issued patent. Infringement of them is not charged.

However, the Lorraine reissued patent says:

“Still another object of my invention is to provide effectual means for automatically controlling the discharge of the oil and gas from the apparatus separately and especially to provide a float device adapted to withstand the pressure that may remain within the separating receptacle and whereby the discharge of the gas and oil is effectually controlled.” (P. 1, lines 98-106.)

It is not contended by plaintiffs that defendants have infringed any improvement invented by Mr. Lorraine and referred to in this statement.

The quoted paragraph refers to two separate and distinct details of alleged improvement: (1) “means for automatically controlling the discharge of the oil and gas from the apparatus separately”, and (2) “especially to provide a float device adapted to withstand the pressure that may remain within the separating receptacle”. (This detail of alleged improvement is in no manner or degree involved in this suit.)

The first of these refers to the specific valve arrangement. This arrangement is such that actuation of the oil outlet valve and actuation of the gas outlet valve is coincident or synchronous. The one float controlled by the rise and fall of the liquid in the trap coincidentally actuates both the oil outlet and the gas outlet valves. This alleged improvement is the subject-matter of claims 3, 4 and 5 of the original Lor-

raine patent 1,373,664 and of the similarly numbered claims of the Lorraine reissued patent in suit. None of these claims are charged to be infringed. Nor is there any charge of infringement of claims 6 to 16, inclusive, of the Lorraine reissued patent, which claims are specifically limited to this automatic and coincident control and operation of the oil and gas valves by the same float. This is a feature of construction which has never been utilized by the defendants. The evidence shows that this valve arrangement was the feature which recommended itself to the users of gas traps and enabled Mr. Lorraine originally to secure a part of the gas trap business. The testimony of the witnesses fully demonstrates this. Examples will be found in the testimony of F. M. Townsend (R. 586-591); M. J. Trumble (R. 725-726); Paul Paine (R. 811).

As said in the opinion of the District Court:

“Bray, as described in Patent No. 1,014,943, dated January 16, 1912, had designed a gas trap which consisted of a large metallic container, the equivalent, so far as the general idea of a container is concerned, to that found in both the plaintiffs’ and the Trumble patents. Bray distributed the incoming oil over perforated conical plates installed in the upper part of his container, there being three in number, one underneath the other. He seems to have considered that it was desirable to break up the oil as an aid to the separation of the gas and for that purpose perforated his conical sections, so as to permit the dripping of the fluid. The Bray patent was cited

in a suit between the same parties as here appear, wherein it was contended by these defendants that their patent had been infringed in certain of its claims by the device manufactured under Lorraine's reissue.

“See Lorraine (appellant) v. Townsend, *et al.*,
290 Fed. 54.

“A reading of that decision, with the citations made in it, shows that the court considered the inventive field a narrow one. Lorraine included in his device two features different from those which had preceded him in that he fed his oil and gas mixture into a chamber built within the main container, walling this chamber off and attaching it to one side of the enclosing cylinder. The inner chamber opened into the main inner receptacle at the top, the lower end of its inner wall being designed to be kept submerged in the oil contained in the main receptacle. He applied, too, a synchronized valve connection attachment of his own invention, the valve being placed outside the receptacle. As the float within the chamber rose or fell with the liquid surface of the oil contained therein, the oil outlet would open or close and the gas outlet would operate in the reverse. A feature of the device of both parties was to increase the gas pressure in the upper part of the chamber as the liquid contents ascended, one function of this pressure being to expel the oil more rapidly. That feature was not new. It was used by Bray before it had been used by either of these parties, as well as Cooper in 1916. The synchronized valve as a separate thing, it seems to be conceded, is entitled to a claim for

originality, but it is not made use of in the Trumble apparatus.” (R. pp. 1112-1114.)

* * * * *

“I have not considered it necessary to enter into a discussion of the functions of the segmented chamber of Lorraine, as compared with the baffle plates of Trumble. The feature of pressure maintained within the chamber is common to both, and not a matter involving a new idea. This is plainly pointed out in Lorraine v. Townsend, *supra*. Within the narrow limits left by a very much occupied field, I think that the segmented chamber and its arrangement in connection with the gas separation device is the only thing, aside from the synchronized valve, that may be said to entitle the Lorraine patent to a claim of validity.

“I find that the charge of infringement is not sustained.

“The decree will therefore be for the defendants and will include costs in their favor.” (R. 1116.)

(Plaintiffs assert that these “claims have been found by the Trial Court in its opinion [Tr. 1116] valid but not infringed.” Upon what finding of the District Court such assertion is based cannot be understood. The District Court’s opinion just quoted does not pass upon the validity of these claims. This is clear from reading the opinion of the District Court.)

The most careful reading of Appellants’ Brief fails to disclose any statement of the invention alleged to be patented by claims 17, 18 or 19 of the Lorraine reissued patent in suit. Nowhere do plaintiffs even attempt to define such alleged invention.

This might most properly be taken as a frank confession that the entire theory upon which the application for the reissue of the original Lorraine patent was predicated, was without substance or foundation. It is a most frank confession that plaintiffs' theory of the Lorraine invention,—upon which theory the case was tried in the District Court,—is without foundation and unsustainable.

In response to defendants' motion for further particulars, plaintiffs stated that they alleged claims 17, 18 and 19 to be infringed, and stated:

“That plaintiff asserts that the novel features set forth in each of said claims is an oil and gas separator arranged for maintaining the oil level above the vertical center of said separator, by means of a float operating in the upper portion of said receptacle and controlling the oil discharge.” (Plaintiffs' Bill of Particulars, Par. III—R. p. 39.)

In the same bill of particulars, plaintiffs say:

“That the Specification of Plaintiff's original Letters Patent was defective and insufficient, in that it failed to describe and claim the arrangement for maintaining the oil level above the vertical center of said separator.” (Plaintiffs' Bill of Particulars, Par. VIII—R. p. 40.)

Why plaintiffs have abandoned this theory is unexplained in Appellants' Opening Brief. Plaintiffs cannot, however, escape from the solemn admission thus made that the original Lorraine patent 1,373,664

“failed to describe and claim the arrangement for maintaining the oil level above the vertical center of said separator.” A comparison of the descriptive portion of the specification of the reissued patent fails to disclose any better description of such “arrangement.”

However, there have been added to the reissued patent three claims, numbered 17, 18 and 19.

In claim 17 a functional clause is appended, which does not describe any structure or device or element or any feature of construction by which the function is accomplished. Said functional statement is: “whereby a substantially uniform volume and level of oil may be maintained in said settling chamber at a point above the vertical center of the receptacle.” The same is true in regard to claim 18. In claim 19 the float is defined as “a float in the upper portion of said receptacle.”

The theory upon which the case was tried in the District Court was that the Lorraine invention resided in maintaining a high oil level in the separating trap. This theory is consistent with plaintiffs’ bill of particulars. It is consistent with the total absence of any reference in the original patent to any oil level or to the maintenance of a high oil level in the trap; consistent with the total absence in the original patent of any advantage or function sought or subserved by any such high oil level. Yet, plaintiffs’ bill of particulars admits and proclaims that the reason for the reissue was that the specification of the original patent “was defective and insufficient, in that it failed to describe

and claim the arrangement for maintaining the oil level above the vertical center of said separator.”

That the theory of the trial in the lower court was that the Lorraine invention resided in maintaining a higher level of oil in the trap than had theretofore been maintained in gas traps, is reflected in the opinion of the District Court. Judge James says:

“Because the owners of the Trumble patent, at a date subsequent to the issuance of the Lorraine patent, cut out the lower baffle plates and adjusted their float so that a higher level of oil might be maintained within the cylinder, Lorraine insists that infringement has resulted. He claims equivalency for his segmented chamber in the additional space provided by the cutting out of the Lorraine baffles. He claims that the raising of the oil level to a mean height within the container adopts his inventive idea. In view of what has been said regarding the state of the art in this field, it is plain enough that, so far as arrangement of the interior chamber is concerned, without his segmented compartment Lorraine’s device would disclose no originality. The addition of his compartment, as is true also of the baffle plates of Trumble, marks but a small advance over devices well known and in prior use. This first claim of Lorraine’s, therefore, should be dismissed as without merit.

“If the second claim—that the raising of the height of the oil in the receiving chamber worked such a great improvement in gas traps as to indicate inventive novelty—is upheld, that conclusion must be declared in the face of the fact that neither singly nor collectively are any different

adjuncts required in raising the oil level than at all times have been parts of the Trumble assemblage. In operating the trap, the liquid is required to be drawn off through an aperture at the bottom or side of the receptacle. The float in the inner chamber, operating upon the outlet valve, opens or closes it as the liquid rises or falls. This feature is common to Trumble, Lorraine and other preceding patents. The gas is carried out at the top or roof of the receptacle, but if the fall of the liquid is so great as that the level reaches the line of the outlet, the gas will blow out and mingle with the oil until the liquid level again rises to seal it. To guard against the latter contingency, the common expedient which would occur to the mind of any intelligent observer would be to raise the oil level by arranging the float device so that the oil outlet valve would close before the fluid level fell far enough to allow the gas to blow out. It can easily be seen that the second claim of Lorraine involves only a matter of adjustment and not of novelty of device. And it was clearly shown by the evidence that the most successful operation of a gas trap, as to the particular last discussed, does not depend upon the oil being carried at about the middle of the receptacle or at any particular or specific height. In its practical working the height of the receptacle may be extended and leave the oil level far below the middle line. And this is equally true of either the Lorraine or Trumble device.” (R. 1114-1115.)

If “the raising of the oil level to a mean height within the container” is the inventive idea sought to

be patented in and by claims 17, 18 and 19, or either of them, then such claims are void as new matter and as being for an invention for which the original Lorraine patent was not granted. The reissue statute does not permit a patent to be reissued for a different invention from that for which the original was granted. We will later discuss this principle further.

That the issue of fact in the trial of this cause in the District Court pertained to such asserted invention of a high oil level in the trap, is demonstrated by the oral testimony in the case. It is demonstrated by the fact that such was the assertion in Mr. Lorraine's own testimony educed by his counsel. It is demonstrated by the testimony of defendants' witnesses Earl W. Bailey (R. 298-352; 359-361); C. W. Cooper (R. 677-713); A. J. Gutzler (R. 267, 440-530); J. C. Macintosh (R. 353, 366-375); William McGraw (R. 95); Charles E. Miller (R. 406-410); Thomas F. Morgan (R. 533-637; 1105-1106); Paul Paine (R. 799-854; 1107); Francis M. Townsend (R. 563-626); Milon Trumble (R. 716-728); E. M. Zoeter (R. 418-422).

The testimony of these witnesses shows that the defendants commenced manufacturing and selling the Trumble gas traps in 1914 (R. 457). Defendants' Exhibit F shows the Trumble gas trap as made and sold by defendants from January, 1915, to about the latter part of 1919 (R. 268). This exhibit shows that means were provided upon all these early Trumble gas traps for regulating the oil level carried in the trap. A wide range of adjustment was provided.

This adjustment was made by adjusting the connection of the float arm or lever B upon the stem or arm E of the valve. In this Exhibit F five different adjustments are indicated. The round circles indicate the holes in which the pivot pin may be placed to connect the float lever or arm B on the valve stem or arm E. The valve by this connection was so arranged as to fully open when the float was raised to its uppermost position by the oil rising in the trap, and the valve was fully closed when the float assumed the position shown in this blue print, Defendants' Exhibit F. This valve controlled the outlet of oil from the trap. It was the oil discharge outlet. Mr. Gutzler said:

“These are adjustments for the men in the field to carry the oil level higher or lower, as they please * * *.” (R. 269.)

The testimony of defendants' other witnesses fully corroborates this testimony. There is no disputing the fact that the defendants' Trumble gas traps *from 1915* on were provided with this means for adjusting or regulating the float so as *to regulate as desired* the quantity of oil which must be in the trap before the valve would be entirely open. This testimony of Mr. Gutzler is corroborated by the testimony of Mr. Townsend, Mr. Trumble, Mr. Paine, Mr. Cooper, and others.

Defendants' Exhibit N is a blue print of one of the original tracings made by defendants October 1, 1915. This tracing was a working drawing produced for the

making of Trumble traps by defendants in 1915, 1916 and the succeeding years. This blue print also shows this same means for adjusting the position of the float and thereby adjusting the level of oil carried in the trap.

Defendants' Exhibit YY is a print of a working drawing made February 13, 1919, by defendants. Traps of this construction were made and sold as early as the forepart of 1919. This exhibit also shows the adjusting mechanism referred to. This print is also of interest as illustrating the change made in the Trumble gas traps when the oil operators changed to resting the traps directly on the ground, instead of mounting these traps upon long, high stand-pipes as illustrated in Defendants' Exhibit AA, photographs of the Midway-Northern Oil Company's Trumble gas trap No. 125, shipped by defendants October 8, 1915 (R. 235). The adjusting means referred to can be clearly seen in both of the photographs forming this exhibit. When the oil company's operators commenced setting their gas traps on the ground, there was no longer any use or necessity for the conical shaped bottoms such as had been previously provided on the Trumble gas traps. These conical bottoms are illustrated in Defendants' Exhibits P, N and YY. To permit the defendant Trumble's traps to be mounted directly on the ground, a bumped bottom was provided on the traps. This is illustrated on Defendants' Exhibit YY by the chalk-marks indicated by the initials "F. M. T." thereon. The cup of the bottom portion of the trap proper was thereby slightly enlarged. But

the location of the mounting of the oil valve and of the float was unchanged. This is brought out in Mr. Townsend's testimony (R. 624). No change at all was made in the mode of operation or the function of the trap by this change.

Other photograph exhibits of 1915 made and sold Trumble gas traps with this float and valve adjustment clearly shown, appear in Book of Exhibits, pp. 235, 236, 250, 252, 253, 254, 255 and 256. Different adjustments of the float lever and its connection with the valve lever and stem are shown in these photographic exhibits. Many of them show the traps as in actual use with the adjustment such as to maintain a relatively high level of oil in the trap, that is to say, a level of oil above the mid-vertical center of the trap. These facts are clearly brought out in the testimony of defendants' respective witnesses. The dates of manufacture, shipment and installation are fully proved. In fact, there is no substantial dispute in regard to these facts; and it would seem that plaintiffs' abandonment of the theory upon which they tried this case in the District Court is because of this abundance of proof.

Defendants' Exhibit P is another blue print from the original working drawing made June 12, 1916, of Trumble gas traps constructed at that time. This exhibit also shows this float adjustment mechanism and shows a trap in which the oil level may be maintained in the trap above the mid-vertical center of the trap. It was upon the testimony of defendants' witnesses

and these exhibits of blue prints of the original drawings made in the years 1915-1919, and these photographic exhibits of the actual old Trumble traps made and installed during these years, that the District Court found:

“* * * that the raising of the height of the oil in the receiving chamber * * * involves only a matter of adjustment and not of novelty of device. * * * And this is equally true of either the Lorraine or Trumble device.” (See Judge James’ opinion—bottom p. 1114 and p. 1115.)

The evidence and proof was conclusive upon this issue. So conclusive that in Appellants’ Opening Brief this finding of fact by the District Court is not challenged. We shall, therefore, not burden this Court with a recitation of the testimony in detail nor refer to other and additional exhibits in support thereof. Should the Court deem there to be any occasion therefor, a careful examination will show that the proof is overwhelming.

The result of this proof upon this law suit is this:

It is established—demonstrated beyond peradventure of doubt—that defendants have been manufacturing Trumble gas traps of the type and construction and interrelation of parts and mode of operation illustrated in these working drawings—corresponding as they do substantially with the Trumble patent—since 1915. The same have been on general sale and in general use not only in California, but in other oil-

fields of the United States and in foreign countries. Defendants' said traps, manufactured and sold years before Lorraine's application for his original patent and years before his alleged invention, contained every substantial element of the Trumble gas traps sought to be held as an infringement of the Lorraine reissued patent.

Viewed, therefore, from every angle, a perfect defense has been made out.

If claims 17, 18 and 19 of the Lorraine reissued patent are construed so as to embrace within them or either of them any of defendants' traps, such claims must necessarily be held void, *because whatever the inventive idea so claimed be found to be*, such construction and interrelation of elements was old and in common use years prior to Lorraine's alleged invention and more than two years prior to his application for the original patent.

This brief, and the presentation of a full justification for the decree appealed from, might end here. This evidence and these exhibits completely justify the opinion and conclusions of the District Court. However, should the Court be interested in further considering all of the defenses existent,—some of which were not passed upon by the District Court,—we shall further develop such defenses.

In Appellants' Brief plaintiffs have contented themselves by taking an advertisement cut of one of defendants' Trumble gas traps. This cut is not to scale and was for advertising purposes only, and is shown

not to be accurate. Nevertheless, plaintiffs content themselves with a mere literal application of the words of claims 17, 18 and 19 to this cut. They assert:

“* * * the language of the claims is so clear and its application to defendants’ device so obvious that additional description would seem superfluous.” (Appellants’ Brief, p. 4.)

And:

“Most briefly, the court will find the situation to be this: *Defendants make and sell a device which is exactly described by the language of each of the claims in suit; every element of each of these claims literally as described therein is found in defendants’ device and each of said corresponding elements performs the same function in the same way and leads to the same result as does the corresponding element and combination of the claims in suit.*” (Italics plaintiffs’.) (Appellants’ Brief, p. 8.)

Plaintiffs’ application of the language of these claims to the advertising cut of defendants’ trap is without any reference or regard whatever to the meaning of such language in the Lorraine reissued patent. Plaintiffs take the literal words, but they do not construe these claims in any manner with regard to the subject-matter of the Lorraine patent, to which they are addressed. Thereby they fall into a most common error.

The Supreme Court, in *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 568, had before it the pioneer patent upon the Westinghouse air brake. In

that patent the claims were in the most general and broadest language. It was asserted that the claims read on the defendant's device literally. The Court found that the Boyden brake worked on a different principle and that, although the words of the claim read literally on defendant's device, there was no infringement. The Court said:

“But even if it be conceded that the Boyden device corresponds with the letter of the Westinghouse claims, that does not settle conclusively the question of infringement. We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided. (Citing cases.)

“The converse is equally true. The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent. ‘An infringement,’ says Mr. Justice Grier in *Burr v. Duryee*, 68 U. S. 1 Wall. 531, 572, ‘involves substantial identity, whether that identity be described by the terms ‘same principle’, same ‘*modus operandi*’, or any other. * * * The argument used to show infringement assumes that every combination of devices in a machine which is used to produce the same effect is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term ‘equivalent’.”

Patents are not granted for mere words. The Lorraine reissue patent is for a machine. The several mechanical elements and their law of cooperation, relation and principle of operation or co-action, is the distinguishing feature.

As said by the Supreme Court in Rubber Tip Pencil Co. v. Howard, 20 Wall. 498:

“An idea of itself is not patentable, but a new device by which it may be made practically useful is. The idea of this patentee was a good one, but his device to give it effect, though useful, was not new. Consequently he took nothing by his patent.”

In making his application for patent Mr. Lorraine describes a specific structure having by virtue of the particular construction and the inter-relation of its parts a certain definite, well defined specific mode of operation. In the reissued Letters Patent this mode of operation and the functions of the elements are most fully set forth. Mr. Lorraine names this structure and its cooperating parts. Mr. Lorraine uses the denomination “receiving chamber” as a term adopted by him to designate a specific thing. He has defined in the specification what that thing is. He uses the name “settling chamber” to denominate a particular thing. He stresses in his specification the functions of such a “settling chamber” and its cooperative law in association with *his* “receiving chamber”.

In construing such claims, therefore, care must be taken to give to such “receiving chamber” and “set-

ting chamber” the construction, attributes, functions and cooperative inter-relation comprehended by Mr. Lorraine’s description from which he has named the same. In judging infringement these terms “receiving chamber” and “settling chamber” must be read with Mr. Lorraine’s meaning and must be read to differentiate from the prior art. A slavish literal word application of these terms to defendants’ traps cannot be made. Appellants’ brief relies upon such a slavish literal application and disregards wholly and totally the meaning of these terms in the claims when interpreted to mean that to which Mr. Lorraine addressed them.

The claims of a patent are supposed to be a definition of the device or machine. As said in *Edison v. American Co.*, 151 Fed. 767, at p. 773:

“The language, even of the reissued claims, considered by itself and giving no force to the words, ‘substantially as set forth,’ may be broad enough to cover it; but that is not sufficient. ‘Infringement should not be determined by a mere decision that the terms of a claim of a valid patent are applicable to the defendant’s device. Two things are not precisely similar because the same words are applicable to each. The question of infringement involves considerations of practical utility and of substantial identity, and therefore must be quantitative as well as qualitative.’ *Goodyear Shoe Mach. Co. v. Spalding* (C. C.), 101 Fed. 990.”

As said in *Bates v. Coe*, 98 U. S. 31:

“Devices in one machine may be called by the same name as those contained in another, and yet they may be quite unlike, in the sense of the patent law, in a case where those in one of the machines perform different functions from those in the other. In determining about similarities and differences, courts of justice are not governed merely by the names of things, but they look at the machines and their devices in the light of what they do or what office or function they perform, and how they perform it, and find that a thing is substantially the same as another, if it performs substantially the same function or office in substantially the same way to obtain substantially the same result; and that devices are substantially different when they perform different duties in a substantially different way, or produce substantially a different result. *Cahoon v. Ring*, 1 Cliff. 620.”

When each of claims 17, 18 and 19 are construed in the light of the disclosure of the drawings and description of the Lorraine reissue patent, the defendants' device fails then to respond to either of such claims in the same sense or meaning.

A few examples will suffice. Claims 17 and 18 call for “a receiving chamber therein for the reception of oil and its constituents”. In the Lorraine patent, this is the initial chamber formed between the vertical partition 19 and the wall of the trap. We have heretofore pointed out the functions and mode of operation of this chamber as denominated in the Lorraine

specification. Each of these claims also calls for “a settling chamber communicating with said receiving chamber”. The kind, formation, and cooperative interrelation of these two chambers is fully stressed in the Lorraine patent specification. (See specification of the Lorraine reissued patent, p. 1, lines 58-71; p. 1, lines 71-84; p. 2, lines 94-115; p. 4, lines 106-127.) No comparable receiving chamber or settling chamber exist in the Trumble device, nor does there exist in defendants’ trap any such interrelated receiving and settling chambers co-operating as described in the Lorraine patent. Clearly, these claims are limited to the specific construction shown in the Lorraine patent drawings and described in his specification. Necessarily they are limited to a combination in which such receiving chamber and such settling chamber are so interrelated as to have the functions and mode of operation and effect the purposes set forth in the Lorraine specification.

Each of claims 17 and 18 end with a functional clause: “whereby a substantially uniform volume and level of oil may be maintained in said settling chamber at a point above the vertical center of said receptacle.” Merely maintaining a substantially uniform volume and level of oil at a point above the vertical center of the receptacle, has no useful function or attribute. This clause of the claim has no foundation in the descriptive specification of the Lorraine patent. The evidence conclusively shows that it is immaterial whether or not the level of oil is

maintained in the trap at a point above the vertical center. The evidence conclusively shows that the essential thing is that oil should be maintained above the outlet through the oil outlet valve. The reason for this is to provide an oil seal so that the gas from the well may not blow directly into the oil line. It is obvious that whether a sufficient oil seal is provided within the trap depends solely upon the operative conditions. The higher the pressure of gas entering the trap in the well, the greater the requirements for oil seal are. It was for this very purpose of adjusting such oil seal that defendants provided all of their traps with the means for adjusting the connection between the float lever or arm and the oil outlet valve stem. But it is immaterial whether such oil seal be carried below, at or above the mid-vertical center of the trap. This is clearly proved by the evidence, and sustained by the findings of the District Court that:

“In its practical working the height of the receptacle may be extended and leave the oil level far below the middle line. And this is equally true of either the Lorraine or Trumble device.”

If, however, any invention could be found in maintaining a substantially uniform volume and level of oil in the settling chamber at a point above the mid-vertical center of the receptacle, such invention was not described or disclosed in the original Lorraine patent or attempted to be patented therein or thereby. On the contrary, plaintiffs admit:

“That the Specification of Plaintiff’s original Letters Patent was defective and insufficient, in

that it failed to describe and claim the arrangement for maintaining the oil level above the vertical center of said separator.” (Plaintiffs’ Bill of Particulars, Par. VIII—R. 40.)

Thereby plaintiffs admit that which is a fact, i. e., that so construing the invention and these claims to exist in the maintenace of the mid-vertical center of the oil in the trap, these claims are not addressed to the same invention attempted to be patented in and by the original patent.

As said in *Parker & Whipple Co. v. Yale Clock Co.*, 123 U. S. 87:

“In these extracts from the opinion it is seen that the court adheres strictly to the view, that, under the statute, the commissioner has no jurisdiction to grant a reissued patent for an invention substantially different from that embodied in the original patent, and that a reissue granted not in accordance with that rule is void. * * *

“In the present case, there was no mistake in the wording of the claim of the original patent. The description warranted no other claim.”

See also:

Eachus v. Broomall, 115 U. S. 429;

Heald v. Rice, 104 U. S. 737.

In *Carpenter Straw Sewing Machine Co. v. Searle*, 52 Fed. 809, at 814, Judge Coxe says:

“These quotations, which have perhaps been multiplied unnecessarily, leave no room for doubt that unless the court can find that the invention

of the reissue is described as the invention in the original, and that the patentee intended to secure it as his invention in the original, the reissue is invalid,—it is not for the same invention. The question is not what the patentee actually invented, but what he said about it in the original, and if it appears from the original that the invention of the reissue was an afterthought not described or intended to be claimed, the reissue falls.”

Plaintiffs’ bill of complaint alleged in Paragraph V (R. 6) that the original letters patent “were inoperative and invalid by reason of the defective and insufficient specification therein”. Defendants-appellants for particulars asked:

“8. Precisely wherein the specification of plaintiffs’ original Letters Patent was defective and insufficient as referred to in Paragraph V of the Bill of Complaint herein.” (R. 16.)

Plaintiffs then pleaded by plaintiffs’ bill of particulars that the original patent failed to describe and claim the arrangement for maintaining the oil level above the vertical center. This admission is an admission that the facts are within the rule of the authorities above cited; that if the invention comprehended by the claims in suit is predicated upon the maintenance of a substantially uniform volume and level of oil in the settling chamber at a point above the vertical mid-center of the receptacle, then this was not for the same invention as patented in the original patent, but for a different invention, and these claims

of the reissued patent are void. There would seem to be no escaping from this conclusion. Plaintiffs' admission is supported by the original patent.

It is well established that a patent on a mere difference in degree of the use of the principle shown in the prior art is invalid.

Smith v. Nichols, 21 Wall. 112;

Grant v. Walter, 148 U. S. 547, 553;

Burt v. Evory, 133 U. S. 349;

Market Street Railway Co. v. Rowley, 155 U. S. 621;

Fox v. Perkins, 52 Fed. 205;

Calvin v. City of Grand Rapids, 53 C. C. A. 165, 115 Fed. 511;

Eames v. Worcester Poly. Institute, 123 Fed. 67.

As said by the Supreme Court in *Atlantic Works v. Brady*, 107 U. S. 192:

“It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacturers. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing

anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to law suits and vexatious accountings for profits made in good faith.”

In fact, claims 17, 18 and 19, if read as asserted in appellants’ brief, fall clearly within the denunciation of the Supreme Court in *Carlton v. Bokee*, 17 Wall. 463:

“All these things exist in the Stuber burner except one. In that burner the wick tube and the dome are not directly connected together. The dome is first connected with the gallery and the gallery with the wick tube. So that the claim is reduced to the same thing which was claimed in the original patent. The same may be said of the second and third claims. If they mean anything more than the claim in the original patent they are void. Being identical with that they are needlessly multiplied, and by exhibiting a seeming of claims to which Reichmann was not entitled they are calculated to confuse and mislead. We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions.”

In the spring of 1921 defendants were modernizing their Trumble gas traps. The requirements of the gusher oil wells of the Santa Fe Springs, Huntington

Beach and Signal Hill fields were for gas and oil separating traps of larger capacity. This occasioned defendants to redesign their traps. Changes in sizes and proportions were necessary. Plaintiffs' Exhibit 8 is a blue print of a working drawing of such traps as were redesigned by defendants in February, 1921. Orders were taken for these traps in February, 1921, and they were sent out during that month. (Testimony A. J. Gutzler, Rec. p. 101.) The testimony of Mr. Townsend and Mr. Gutzler shows that immediately upon the issuance of the original Lorraine patent on April 5, 1921, this patent was examined by Mr. Townsend, who is a registered patent attorney in the United States Patent Office and who had over twenty years experience in the procuring for inventors of patents before the United States Patent Office. He also submitted it to his attorneys. It was found that the five claims of said original Lorraine patent were precisely limited to the particular arrangement of receiving and settling chamber intercommunicating at the bottom, these chambers being formed by a vertical partition within the trap, and to the automatic or synchronized valve mechanism and its operation. The new large size Trumble gas trap illustrated in plaintiffs' Exhibit 8 did not contain any of these features. It was apparent to Mr. Townsend and he was so advised by his attorneys that said original patent did not in any manner cover or embrace this enlarged Trumble gas trap. That said trap did not infringe said original Lorraine patent. (This fact is conceded by plaintiffs. No

claim of infringement of said claims has ever been made.)

Relying upon this condition and scope of the Lorraine original patent defendants proceeded to put out these enlarged Trumble gas traps. Many of them were actually installed prior to the date of the application for the Lorraine reissue.

This enlarged Trumble gas trap (exemplified in plaintiffs' Exhibit 8) was a mere redesigning of the prior Trumble traps. Changes in size and proportion were made. Instead of a ball float a different form of float was used. But this was a mere redesigning of the trap. As said by the Supreme Court in *Smith v. Nichols*, 21 Wall. 112:

“But a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.”

Defendants used ordinary mechanical skill in determining the size and proportion of the parts.

Defendants relied upon the contract between the government and Mr. Lorraine exemplified in the original patent. Defendants invested their money and proceeded with their business of manufacturing these enlarged traps, relying upon non-infringement of said original Lorraine Letters Patent. This they had a right to do. The rule applied by this court in Supreme

Mfg. Corporation v. Security Mfg. Co., 299 Fed. 65, applies. This court said:

“The appellant here has intervening rights as against the reissue, for it has acquired the right to manufacture and sell that which Ells failed to claim, and, having expended considerable sums of money in the manufacture of a device at a time when the original Ells patent was as yet unsurrendered, it cannot be held to infringe the added claims of the reissue. *Ives v. Sargent*, 119 U. S. 652, 7 Sup. Ct. 436, 30 L. Ed. 544; *Autopiano Co. v. American Player Action Co.*, 222 Fed. 276, 138 C. C. A. 38; *Diamond Drill Contracting Co. v. Mitchell* (C. C. A.), 269 Fed. 261; *Keller v. Adams-Campbell Co.* (C. C. A.), 287 Fed. 838; *Ashley v. Samuel C. Tatum Co.* (D. C.), 240 Fed. 979. We find no conflict between these views and the decision in *Abercrombie & Fitch Co. v. Baldwin*, 245 U. S. 198; 38 Sup. Ct. 104, 62 L. Ed. 240, cited by the appellee. In the latter case it was held that the reissue did not enlarge the original patent, and the court was of the opinion that the original claims were sufficient in their scope to include, under the doctrine of equivalents, the more explicit claims of the reissue. It is manifest that in such a case there could be no loss of rights by delay in applying for a reissue, and there could be no impediment by way of intervening rights; the original claims being found sufficient to protect the whole invention of the patentee.”

If, therefore, for the sake of argument, it could be conceded that claims 17, 18 or 19 of the Lorraine Reissue patent states a patentable invention, patentably

novel at the date of the application for the Lorraine original patent, and that such claims are not limited to the precise construction or inter-relation and co-action of the receiving chamber and settling chamber, etc., but could be construed to cover defendants' enlarged Trumble traps, like plaintiffs' Exhibit 8, defendants' intervening rights bar any suit by plaintiffs on such reissued patent against this defendant.

Conclusion.

In conclusion, therefore, defendants submit:

1. That the District Court was correct in its finding that if any invention existed in the Lorraine Reissue patent, such invention was limited to the precise details of construction of such "receiving chamber" and "settling chamber", so formed by the vertical partition 19, and to the automatic or synchronized valve mechanism. That the adjustment and regulation of the height of the oil level was a mere matter of degree and a mere matter of adjustment and did not rise to the dignity of invention

2. That if either claims 17, 18 or 19 of the Lorraine Reissue patent could be interpreted of sufficient breadth to embrace defendants' present Trumble traps, then each of such claims is void as fully and completely anticipated by the Trumble traps manufactured by these defendants commencing with the year 1915 and sold for years prior to the alleged Lorraine invention. That which infringes if subsequent, anticipates if prior.

3. That claims 17, 18 and 19 of the Reissued patent are void, if not limited to the specific “receiving chamber” and “settling chamber” of the Lorraine construction. This because, if not so limited, then such claims are for a different invention from that for which the original patent was constructed and granted. To so construe said claims would be to construe them for “new” matter. This is within the inhibition of the reissue statutes.

4. The cause of action attempted to be asserted by plaintiffs is barred by the intervening rights of the defendants.

5. The District Court was correct in holding non-infringement. Defendants’ traps have not embodied in them any inventive idea produced by Mr. Lorraine. We submit that the District Court was correct in its conclusion that:

“I have not considered it necessary to enter into a discussion of the functions of the segmented chamber of Lorraine, as compared with the baffle plates of Trumble. The feature of pressure maintained within the chamber is common to both, and not a matter involving a new idea. This is plainly pointed out in *Lorraine v. Townsend*, *supra*. Within the narrow limits left by a very much occupied field, I think that the segmented chamber and its arrangement in connection with the gas separation device is the only thing, aside from the synchronized valve, that may be said to entitle the Lorraine patent to a claim of validity.

“I find that the charge of infringement is not sustained.” [R. 116.]

We respectfully submit that the decree dismissing the bill and the supplemental bill was correct and should be affirmed.

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